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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARY J. FORD, MARK D. KILPATRICK, and
PHILLIP W. WHITAKER, JR.

Appeal 2008-4690
Application 10/814,226
Technology Center 3700

Decided:¹ March 19, 2009

Before DONALD E. ADAMS, DEMETRA J. MILLS, and RICHARD M.
LEBOVITZ, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This appeal under 35 U.S.C. § 134 involves claims 1-12, 14-32, and 34-40, the only claims pending in this application. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to a prefabricated flooring system (claims 1-12, 14-23, and 38-40) and a bowling alley flooring system (claims 24-32 and 34-37). Claims 1, 2, and 14 are illustrative:

1. A prefabricated flooring system adapted for use in a bowling center, comprising a plurality of wooden boards having a longitudinal axis, the plurality of wooden boards each having substantially flat side edges along the longitudinal axis, interior boards of the plurality of wooden boards being bonded together by an adhesive applied on the side edges and two of the outermost boards of the plurality of wooden boards being bonded only on one side edge by the adhesive to adjacent corresponding interior boards to form a preformed section of wooden boards.

2. The system of claim 1, wherein a thickness of the plurality of wooden boards is less than $2\frac{3}{4}$ inches.

14. The system of claim 1, further comprising an integrated foul line of contrasting material bonded to an edge of the preformed section of wooden boards substantially perpendicular to the longitudinal axis.

The Examiner relies on the following prior art references to show unpatentability:

De Vore	US 2,969,983	Jan. 31, 1961
Heddon	US 5,348,513	Sep. 20, 1994

The rejections presented by the Examiner are as follows:

1. Claims 1, 6, 8, 9, 19, 24, 25, 30, 38, and 39 stand rejected under 35 U.S.C. § 102(b) as being anticipated by De Vore.

2. Claims 2-5, 7, 10-12, 17, 18, 20-23, 26-29, 31, 32, 35-37, and 40 stand rejected under 35 U.S.C § 103(a) as unpatentable over De Vore.

3. Claims 14-16 and 34 stand rejected under 35 U.S.C § 103(a) as unpatentable over the combination of De Vore and Heddon.

We reverse.

Anticipation:

ISSUE

Did the Examiner meet his burden of establishing a prima facie case of anticipation?

FINDINGS OF FACT

FF 1. De Vore “relates to improvements in bowling alleys and particularly to the construction thereof in the securing of the bowling alley surface boards” (De Vore, col. 1, ll. 15-17).

FF 2. De Vore teaches that “[a]s is well known bowling alleys are formed of a relatively large number of relatively narrow boards laid side by side with the edge grain upwardly” (De Vore, col. 1, ll. 18-20).

FF 3. De Vore discloses that “the principal object of the present invention [is] to provide a bowling alley in which the boards are retained in operative relation to one another and to a supporting structure without the use of material damaging means such as nails, screws or the like” (De Vore, col. 1, ll. 49-54).

FF 4. The Examiner finds that De Vore uses adhesive to hold the boards together (Ans. 4). More specifically, the Examiner finds that De Vore teaches that “the adhesive...is to a certain extent forced between the

contacting surfaces of said boards...not only securing the contacting lower surfaces of the alley boards and side boards to the upper surfaces of the base boards but likewise and simultaneously securing the said boards to one another” (*id.*, quoting De Vore, col. 5, ll. 57-64).

FF 5. Appellants’ Specification discloses that “[i]n the applications of the invention, the flooring system can be readily prefabricated at the factory in order to reduce installation time at the bowling alley” (Spec. 13: 12-14).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros, Inc.. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

Claim 1 is drawn to a prefabricated flooring system. According to claim 1, the flooring system is adapted for use in a bowling center. Further, the claimed flooring system comprises a plurality of wooden boards having a

longitudinal axis, wherein each wooden board has substantially flat side edges along the longitudinal axis.

Claim 1 requires the interior boards of the plurality of wooden boards to be bonded together by an adhesive applied on the side edges and two of the outermost boards of the plurality of wooden boards to be bonded only on one side edge by the adhesive to adjacent corresponding interior boards.

Claim 1 requires the structure to form a preformed section of wooden boards. Stated differently, the structure resulting from bonding the plurality of wooden boards together is a prefabricated flooring system.

Independent claims 24 and 38 also require, *inter alia*, the use of an adhesive to bond a plurality of wooden boards together to form prefabricated (claim 24) or a preformed (claim 38) section of wooden boards. The remaining claims before us for review depend directly or indirectly from one of claims 1, 24, or 38.

Appellants contend that

The term “prefabricated”, as defined by the on-line version of the American Heritage® Dictionary of the English Language is:

To manufacture (a building or section of a building, for example) in advance, especially in standard sections that can be easily shipped and assembled.

(App. Br. 6.) In this regard, Appellants contend that “as is . . . clear from a fair reading of De Vore, the bowling lane is fabricated at the site of the bowling center” (*id.*). More specifically, Appellants contend that “the flooring system of De Vore must be assembled on site, using a complex system of clamps, wires, planks, gluing, etc. For this reason, the flooring system of De Vore is not prefabricated” (App. Br. 7). We agree.

The Examiner appears to recognize that the terms prefabricated or preformed require something different than the installation of non-prefabricated or non-preformed boards at an installation site, e.g., at a factory (Ans. 8; FF 5). In this regard, the Examiner asserts that De Vore's baseboards and alley boards "are parts fabricated at a factory so that the alley can be assembled of standardized parts such that . . . [De Vore] clearly meets" Appellants' claim limitations requiring a preformed section of wooden boards or prefabricated section of wooden boards (Ans. 7). We are not persuaded.

No doubt, wooden boards can be milled into standardized dimensions at a site that is distinct from their installation site. Appellants' claims are not, however, limited to the use of dimensional boards that can be obtained from e.g., a mill. Instead, Appellants' claimed invention requires that a plurality of wooden boards are bonded together, in a particular arrangement, through the use of an adhesive to produce a "preformed section of wooden boards" or a "prefabricated" section.

The Examiner has not identified a teaching in De Vore of bonding a plurality of wooden boards together into a particular arrangement (e.g., structure) at a location that is distinct from the installation site. Accordingly, we are not persuaded by the Examiner's conclusion that the "terms prefabricated and preformed impart no known structural difference over the applied art" (*id.*). To the contrary, there can be no doubt that a single piece of dimensional lumber (e.g., a 2 by 4) has a structure that is distinct from a plurality of 2 by 4's that are bonded together along their side edges. The Examiner has not addressed this structural difference. Accordingly, the preponderance of the evidence on this record favors Appellants.

CONCLUSION OF LAW

The Examiner failed to meet his burden of establishing a prima facie case of anticipation. The rejection of claims 1, 6, 8, 9, 19, 24, 25, 30, 38, and 39 under 35 U.S.C. § 102(b) as anticipated by De Vore is reversed.

Obviousness:

PRINCIPLES OF LAW

“In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art.” *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). “In determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995) (internal quotations omitted).

De Vore alone:

ISSUE

Did the Examiner meet his burden of establishing a prima facie case of obviousness?

FINDINGS OF FACT

FF 6. The Examiner finds that the various limitations of the rejected claims are, *inter alia*, “an obvious matter of choice” or “well known” (Ans. 5).

ANALYSIS

For the reasons set forth above, we disagree with the Examiner's conclusion that De Vore teaches a prefabricated or preformed section of wooden boards. The Examiner has not provided evidence or reasoning as to why it would have been prima facie obvious for a person of ordinary skill in this art to bond a plurality of wooden boards, in a particular arrangement, through the use of an adhesive to arrive at a "preformed section of wooden boards" or a "prefabricated" section of wooden boards that falls within the scope of Appellants' claims. *Fritch*, 972 F.2d at 1265.

CONCLUSION OF LAW

The Examiner failed to meet his burden of establishing a prima facie case of obviousness. The rejection of claims 2-5, 7, 10-12, 17, 18, 20-23, 26-29, 31, 32, 35-37, and 40 under 35 U.S.C § 103(a) as unpatentable over De Vore is reversed.

The combination of De Vore and Heddon:

ISSUE

Did the Examiner meet his burden of establishing a prima facie case of obviousness?

FINDINGS OF FACT

FF 7. The Examiner finds that "Devore [sic] does not detail his foul line 12. Heddon teaches the use of embedded foul lines at the edge of lane panels. To have used a separated bonded piece as foul line 12 in De[]Vore

would have been [an] obvious method of making foul lines known in the art”
(Ans. 6).

ANALYSIS

For the reasons set forth above, we disagree with the Examiner’s conclusion that De Vore teaches a prefabricated or preformed section of wooden boards. The Examiner has not explained how Heddon makes up for this deficiency in De Vore. Accordingly, the Examiner has not met his burden of providing evidence or reasoning as to why it would have been prima facie obvious for a person of ordinary skill in this art to bond a plurality of wooden boards, in a particular arrangement, through the use of an adhesive to produce a “preformed section of wooden boards” or a “prefabricated” section of wooden boards that falls within the scope of Appellants’ claims. *Fritch*, 972 F.2d at 1265.

CONCLUSION OF LAW

The Examiner failed to meet his burden of establishing a prima facie case of obviousness. The rejection of claims 14-16 and 34 under 35 U.S.C § 103(a) as unpatentable over the combination of De Vore and Heddon is reversed.

REVERSED

cdc

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